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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/529,390

03/28/2005

Michael Porat

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02/20/2008

DENNISON, SCHULTZ & MACDONALD

1727 KING STREET

SUITE 105

ALEXANDRIA, VA 22314

EXAMINER

MATTER, KRISTIN CLARETTE

ART UNIT

PAPER NUMBER

3771

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/529,390

**Applicant(s)**

PORAT, MICHAEL

**Examiner**

KRISTEN C. MATTER

**Art Unit**

3771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,6,8-13,15,16,18-20,23,27 and 28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,6-13,15,16,18-20,23,27 and 28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 March 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Final Drawing Review (PTO-849)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 3/28/2005
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Drawings***

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 4 (page 9).

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 20b (Figure 9). Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

The disclosure is objected to because of the following informalities: on page 5, line 23, "a hood masks" should be changed to --hood masks-- to fix the typographical mistake.

Appropriate correction is required.

***Claim Objections***

Claim 6 is objected to because of the following informalities: in line 1, "a mask in claim 1" should be changed to --a mask as in claim 1-- to fix the typographical mistake. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 6, 12, 16, and 28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 6, 12, and 16, reference is made to the user's eyes, mouth, nose, and lips and as written it appears as though Applicant is trying to positively claim these human body parts. Examiner suggests adding "adapted to be" or "configured to be" language in the claims to avoid the confusion of appearing to claim unstatutory subject matter.

Claim 28 recites the limitation "separate elastic sealing means as in claim 1" in lines 5-6. There is insufficient antecedent basis for this limitation in the claim because the sealing means was not defined as elastic in claim 1. The elastic sealing means is also referenced in line 9.

***Claim Rejections - 35 USC § 102/35 USC § 103***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 6, 8, 12, 16, 23, and 27, are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Richardson (US 6,134,716).

Regarding claims 1, 6, 12, 16, and 27, Richardson discloses a mask that enables one to breathe filtered air comprising a hood (12) that includes a bag of transparent film material impermeable to gases (see column 5, lines 35-40), a filter assembly (18) connected to the bag (column 3, lines 1-20) and exhalation valve (20) worn in the area of a user's nose and/or mouth (see Figure 1), and a separate sealing means (60, 62), not attached to the bag, to seal around the neck. To the extent, if any, that Richardson does not clearly mention the material is impermeable to gases, Examiner points to the fact that the hood has valves and filters and to column 4, lines 48-49, in which Richardson discloses the strap is for preventing contaminated air from entering the interior of the hood. This seems to clearly indicate that the bag is made of an impermeable film material, but regardless, it is obvious to one of skill in the art to make a hood for protecting against air toxins from a material that is impermeable to gases. The flexible nature of the hood inherently makes the hood foldable to pocket size.

Regarding claim 8, “Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985)(citations omitted). In this case, Richardson discloses the filter member as sealed to the inner surface of the hood (column 3, lines 8-11) but does not specifically state that it is heat sealed (although Richardson does disclose the bag itself is heat-sealed in column 4, line 16). It is well known to persons of ordinary skill in the art to heat seal plastic materials as an effective means for creating air-tight barriers and therefore would have been obvious to one of ordinary skill in the art to heat seal the filter assembly onto the bag.

Regarding claim 23, Richardson does not specifically state that the hood is turned inside out after use, however, the flexible nature of the hood material inherently allows the hood to be turned inside out after removal from the head.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Richardson as applied to claims 1, 6, 8, 12, 16, 23, and 27 above, and further in view of McGuinness (H1316). Richardson does not disclose the hood as being made of a laminate of more than one plastic material. However, McGuinness discloses a similar protective hood formed from plastic laminates of more than one material (see column 2, lines 43-52). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have made the hood of Richardson from a plastic laminate as disclosed by McGuinness in order to more

effective protect the user from contaminants for extended periods of time. In addition, it appears as though the device disclosed by Richardson would perform equally well with a hood made of a plastic laminate as opposed to a single layer of plastic film.

Claims 9-11 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Richardson as applied to claims 1, 6, 8, 12, 16, 23, and 27 above, and further in view of Wen (US 6,681,765).

Regarding claims 9 and 11, Richardson discloses a multilayer filter with active charcoal but is silent as to an antiseptic. Wen discloses, in a respiration mask, a multilayer filter with charcoal and antiseptic agents including chlorohexidine (see column 2, lines 55-60). It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided Richardson's filter with an antiseptic agent as taught by Wen in order to more effectively protect the user from viruses and bacteria in the contaminated air. Furthermore, it appears as though the device disclosed by Richardson would perform equally well with the antiseptic layer.

Regarding claim 10, Wen does not disclose that the charcoal is sandwiched between multiple layers of antiseptic agents. However, absent a critical teaching and/or a showing of unexpected results from having a charcoal layer sandwiched between the antiseptic layers, Examiner contends it would have been an obvious design consideration to one of ordinary skill in the art at the time of the invention to have used two antiseptic layers surrounding a charcoal layer in the multilayer filter disclosed by the modified Richardson reference in order to use multiple antiseptic agents for example or for more effective protection against viruses and

bacteria. Furthermore, it appears as though the device disclosed by Richardson and Wen would perform equally well with the antiseptic layers sandwiching the charcoal layer.

Regarding claim 13, Richardson does not disclose the particle sizes filtered by the filter. However, the limitation "greater than 2 microns" includes macroparticles that would inherently be filtered out by the filter of Richardson (i.e., large dust). In any case, Wen discloses that the filter filters out particles in excess of 0.3 microns (column 5, line 60), which overlaps the claimed range of greater than 2 microns. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have designed the filter of Richardson to filter out particles greater than 2 microns in order to prevent contaminants from being breathed in by the user.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Richardson as applied to claims 1, 6, 8, 12, 16, 23, and 27 above, and further in view of Courtney (US 4,981,134). Richardson does not disclose the valve as being embedded in the filter. However, Courtney discloses a filter assembly for a face mask that includes an exhalation valve (7) embedded in the filter assembly (see Figure 1). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used a filter assembly as taught by Courtney in the mask of Richardson in order to allow the valve and filter to both be easily replaced as needed.



Claims 18-20 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Richardson as applied to claims 1, 6, 8, 12, 16, 23, and 27 above, and further in view of Siberell (US 5,263,202).

Regarding claims 18 and 20, Richardson does not disclose that the sealing means is elastic. However, Siberell discloses an elastic drawstring for use in clothing devices (see column 2, line 8). It would have been obvious to one of ordinary skill in the art at the time of the invention to have made the drawstring of Richardson elastic as taught by Siberell in order to provide a snug seal for sealing the neck from contaminants. In addition, the drawstring of Richardson provides a good seal and does not choke the wearer.

Regarding claim 19, Richardson does not disclose 2 drawstrings. However, it is well known to those of ordinary skill in the art that drawstrings are replaceable and therefore it would have been an obvious design consideration to one of ordinary skill in the art at the time of the invention to have provided a second (i.e., spare) elastic drawstring in the mask of Richardson in order to replace the drawstring should it break, for example.

Regarding claim 28, the modified device disclosed by Richardson and Siberell has all of the structural limitations needed to perform the recited method steps, including unfolding the hood and stretching an elastic sealing means over the hood and around the neck, and is fully capable of doing so. It would have been obvious to one of ordinary skill in the art at the time the invention was made, upon seeing the modified Richardson device, to perform the recited method steps of the instant claim 28.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Richardson and Nur et al. are cited to show other filtered escape masks.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KRISTEN C. MATTER whose telephone number is (571)272-5270. The examiner can normally be reached on Monday - Friday 9-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Justine Yu can be reached on (571) 272-4835. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kristen C. Matter/  
Examiner, Art Unit 3771

/Justine R Yu/  
Supervisory Patent Examiner, Art Unit 3771